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McIntyre Harbin & King  
500 Ninth Street, SE  
Washington, DC 20003

EXAMINER
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ALAM, SHAHID AL

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GHASSAN CHIDIAC, SANJAY GUPTA,  
JEFF NORDYKE, GIANCARLO PALLESCHI,  
MATTHEW ROSENTHAL, and ARNOLD O. VIMBA

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Appeal 2008-5219  
Application 09/730,219<sup>1</sup>  
Technology Center 2100

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Decided: <sup>2</sup> February 24, 2009

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Before JOHN C. MARTIN, JEAN R. HOMERE, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application filed December 5, 2000. The real party in interest is International Business Machines, Inc.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-23 mailed April 6, 2006, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

## A. INVENTION

Appellants invented a method, system, and computer program product for enabling network access to a repository of formatted data files. The request initiated translation is governed by a rules-based translation service which determines which stored file formats should be used in performing a translation to a requested file format. (Spec. 1.)

## B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-23. Claims 1, 12, and 23 are independent claims. Claim 1 is illustrative:

1. A computer-implemented method for selecting a file format from a plurality of stored file formats for use in performing a translation from a selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested format;

determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation to said requested file format;

translating the optimal file format of said data file determined in said determining step to the requested file format; and

providing the requested file format to a user.

### C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Ogawa                      US 5,608,874                      Mar. 4, 1997

*Alleged* Applicant Admitted Prior Art (AAPA), *see* Specification, page 3, second paragraph.

### D. REJECTION

The Examiner entered the following rejection which is before us for review:

(1) Claims 1-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogawa in view of AAPA.

## II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed an Appeal Brief (App. Br.) on September 6, 2006.<sup>3</sup> The Examiner mailed an Examiner's Answer (Ans.) on July 27, 2007. Appellants filed a Reply Brief (Reply Br.) on January 29, 2007. An Oral Hearing was held at the U.S. Patent and Trademark Office on February 11, 2009.

## III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

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<sup>3</sup> All citations herein to the Appeal Brief are to the Substitute Appeal Brief filed on March 1, 2007.

*Specification*

1. The Specification discloses:

Accordingly, it can be seen that there is a need to provide a seamless data format translation or transcoding scheme to further improve inter-enterprise data exchange.

Since it may often be the case that a requested data file exists within an enterprise in many different formats other than the requested format, a further advantageous aspect of the transcoding scheme would provide logic for selecting the optimal version of a requested data file from which to perform the translation.

(Spec. 3.)

*Ogawa*

2. Ogawa discloses a system capable of receiving data from a wide variety of remote sources, identifying the format of the data, translating the data to a common format, sending the data to a recipient in an intermediate format, then translating the data to the specific format needed by the particular recipient (Col. 2, ll. 53-59.)

IV. PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Brief to show error in

the proffered prima facie case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## V. ANALYSIS

### *Common Feature in All Claims*

Our representative claim, claim 1, recites, *inter alia*, “determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation to said requested file format.” Independent claims 12 and 23 recite similar limitations. Thus, the scope of each of the independent claims includes “determining an optimal file format from a plurality of formats for use in performing a translation to a requested file format.”

### *The Obviousness Rejection*

We now consider the Examiner’s rejection of claims 1-23 under 35 U.S.C. § 103(a) as being obvious over the combination of Ogawa and AAPA.

The Examiner found that “Ogawa does not explicitly teach an optimal file format from a plurality of stored file formats as claimed” (Ans. 12) (bolding omitted), but seems to suggest that the determining step of claim 1 is taught by an admission made by Appellants on page 3 of the Specification (AAPA). Appellants conceded during the oral hearing that the cited

disclosure at page 3 constitutes admitted prior art to the extent it states that “it may often be the case that a requested data file exists within an enterprise in many different formats other than the requested format.” The Examiner, in finding that “APA discloses [the] claimed optimal file format from a plurality of file format[s],” additionally relies on the rest of the cited disclosure at page 3 as an admission that it was known to “select[] the optimal version of a requested data file from which to perform the translation.” (Ans. 4.)

Appellants contend:

Thus, the “transcoding scheme” referred to in applicants’ specification (which provides for selecting an optimal version) is not an “admission” but clearly refers back to the “transcoding scheme” of the preceding sentence. In short, the quoted passage does not characterize a pre-existing prior art system or scheme. There simply is no admitted prior art as the examiner erroneously concluded.

(App. Br. 7.)

Appellants further contend that “nothing in the USPTO rules or regulations mandate that applicants exclude characterizing their invention . . . in the background section of the specification, or be subject to a risk that such statement be deemed admitted prior art. . . . [T]he overall disclosure clearly indicates that the alleged prior art is, in fact, part of the invention claimed” (Reply Br. 3). We agree with Appellants insofar as the recitation of “selecting the optimal version of a requested data file from which to perform the translation” is concerned,

By using the term “Background of the Invention” there is a presumption that the described subject matter in such a section is “prior art”

absent an express denial by Appellants. However, in this case Appellants have expressly denied such an admission.

Furthermore, we find that Appellants' statement that "*the transcoding scheme would provide logic for selecting the optimal version of a requested data file from which to perform the translation,*" although found in the Background of the Invention section, is not an "admission" but rather a statement regarding *the need to provide* a scheme to further improve inter-enterprise data exchange (FF 1). Defining a need suggests something that does not yet exist. While the above-noted statement may be misplaced in the Specification's Background section, we find that this is not enough to launch such a statement into an admission of prior art.

Thus, Appellants correctly point out that the entirety of the disclosure at page 3 of the Specification is not an admission of prior art as contended by the Examiner. Thus, the record does not contain evidence that supports the Examiner's position that Appellants' Specification admits that it was known that an optimal file format can be selected from a plurality of file formats.

In addition, Appellants contend that "[s]ince Ogawa '874 uses a standard, intermediate, common format for a first conversion of a legacy file (in order to enable uniform secondary translation scheme to obtain a requested file format), Ogawa has no need [to] choose any particular starting format (or any optimal format) to begin a translation" (App. Br. 9). We agree.



Ogawa takes every legacy file and translates it into a common file format (FF 2). Thus, we agree that Ogawa does not determine an optimal file format from a plurality of formats for use in performing the translation.

We find that Appellants have shown error in the Examiner's rejection. Therefore, we reverse the rejection of illustrative claim 1 and of claims 2-23, which fall therewith.

## VI. CONCLUSION

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-23.

## VII. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-23.

REVERSED

msc

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